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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rieke Corporation

Serial No. 74/611,247

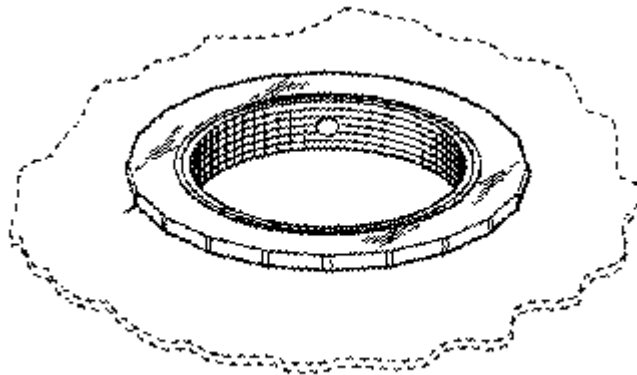
James M. Durlacher of Woodard, Emhardt, Naughton, Moriarity
& McNett for Rieke Corporation.

Barbara Gaynor, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Simms, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 15, 1994, applicant applied to register the
configuration shown below



on the Principal Register for what were subsequently identified by amendment as "container closures as installed in metal drums, namely, a crimped-in-place flange and drum end embossment combination." Use since September 3, 1943 was claimed. The mark was described as consisting of "the distinctive design configuration of a closure flange which is crimped in place within an embossment of a metal drum." Applicant explained that the lining on the drawing is for shading purposes only and does not represent color.

Registration was initially refused under Sections 1, 2 and 45 of the Act on the ground that the configuration sought to be registered is functional. Further, the Examining Attorney held that even if the proposed mark is de facto functional, rather than de jure functional, because the design is not inherently distinctive, it would only be registrable on the Principal Register with a showing of acquired distinctiveness under Section 2(f) of the Act.

Responsive to the refusal to register, applicant argued that registration on the Principal Register is appropriate because the configuration has acquired distinctiveness. In support of this claim, applicant submitted six pieces of evidence.

The first is the affidavit of Philip Keating, President of applicant. He states that he has worked for applicant for thirty-two years; that one of applicant's competitors is the American Flange Manufacturing Company in Carol Stream, Ohio, which has, for at least fifty years, produced a flange/embossment combination with an octagonal lip around its periphery where the flange is anchored into the raised metal embossment; that the American Flange Company's product is constructed in a manner similar to the way applicant's product is constructed, in that the embossment is crimped around the lip of the flange, but that the shape of the crimped embossment when the American Flange Company's product is used is octagonal, whereas "the Rieke Corporation product shape involves a series of peripheral indentations corresponding to the flange serrations"; that both products meet the applicable performance standards for such goods; that both are equally feasible, efficient and competitive designs; that the resulting configurations of the crimped embossments are different; and that "the series of peripheral indentations representative of the Rieke design are distinctive and clearly different from the resultant appearance of the American Flange Company design."

Applicant also submitted a copy of an "early operating and service manual" which explains to the operators of presses used to install applicant's closures what applicant's dies are and how to use them to build applicant's closures into steel drums. The configuration of

the flange crimped into the embossment is shown in this manual, but neither the text not the illustrations emphasizes the appearance of the installed flange or claims the configuration as applicant's trademark.

The next exhibit is a copy of applicant's annual report for 1950. The configuration which is the subject of this application is shown on the cover of the report as well as elsewhere in it. It is not, however, claimed or identified as a trademark for applicant's goods.

The fourth exhibit to applicant's response is a copy of a more recent catalog for applicant's goods. In connection with a picture of the complete embossment, flange and plug assembly, the text of the catalog notes that "the serrations are locked into the drum metal completely around the perimeter of the drum embossment."

Two affidavits were also submitted in support of applicant's claim. One is from Roger P. Thomas, an employee of applicant for twenty-nine years, who was the sales vice president at the time of his affidavit. Mr. Thomas states that applicant has distributed catalogs with detailed information concerning applicant's flange/embossment combination for the last fifty years, with twenty-two hundred going out in 1995 alone. The other affidavit is from applicant's marketing vice president, Eric T. Rieke, who has been an employee of applicant for thirty-one years. Mr. Rieke states that applicant has sold an average of ten million units embodying its flange/embossment combination

per year for the last twenty years; that once the drum is fitted with applicant's flange, resulting in the described configuration, the drum goes to a filler, and then to an end user, it is returned, reconditioned (cleaned) and then returned to the filler; that this cycle is repeated three to five times each year, resulting in the presentation of the flange/embossment combination to the users thereof somewhere between thirty to fifty million times each year.

The Examining Attorney withdrew the refusal based on de jure functionality. She concluded that applicant had not established secondary meaning, so she suggested that applicant amend the application to seek registration on the Supplemental Register.

Applicant responded with argument and additional evidence on the issue of acquired distinctiveness. Three declarations were submitted. One is from Larry Rysavy, the vice president of Third Coast Packaging, which is in the business of packaging petroleum products. Another is from Jerry Billups, the vice president for sales and marketing of Republic Container, a manufacturer of steel drums. The third declaration is from William Megargle, who is Packaging Manager of FMC Corporation, Agricultural Chemical Group, a manufacturer of agricultural chemicals. Each of these three gentlemen attests to decades of experience in his field, and each states that as part of his job he frequently sees metal drums which are to be filled with particular products; that while he has seen different flange styles over the years, he

is familiar with the "unique serration design used by Rieke Corporation and the distinctive appearance of the flange and neck finish once the Rieke Corporation combination is crimped into a preformed boss on the container lid." Each declarant offers his opinion that the distinctive appearance of the Rieke Corporation combination functions as a trademark, indicating the source of origin for the goods. None of these men has seen any similar design from a different source of origin, and each recognizes the configuration sought to be registered as an indication that applicant is the source of it. Each man attests to his opinion that the shape and geometry of the embossment when it is crimped over applicant's flange is generally recognized by others in the container filling field as an indication that the container closure emanates from applicant because of its unique design and applicant's long and widespread use of the combination.

Applicant also filed a notice of appeal. The appeal was instituted, but action on it was suspended and the application was remanded for reconsideration by the Examining Attorney. She was not persuaded by applicant's evidence and argument, however, and the application was returned to the Board for resumption of action on the appeal.

Applicant filed a brief, attaching a copy of the file of Registration No, 1,732, 470, which issued to the aforementioned American Flange and Manufacturing Co., Inc.

on November 17, 1992. Applicant made arguments based on the issuance of this registration, the subject matter of which is apparently American Flange's container closure flange and embossment configuration.

The Examining Attorney filed her appeal brief, objecting to the untimely submission of the above-referenced registration file with applicant's brief. Her objection is well taken. Under Trademark Rule 2.142(d), the record in the application closes with the filing of the notice of appeal. Additional evidence is not admitted unless the Board grants a request to consider it. In the case at hand, applicant did not make such a request, so we have not considered this exhibit or the arguments made based on it.

The law is well settled with respect to the issue of whether a configuration of a product is registrable. "A design configuration is considered to be unregistrable when it has been determined to be de jure, as opposed to de facto, functional. An item which is de facto functional may be registrable, while one which is de jure functional may never be registered even if it has been shown to possess some recognition in the trade." In re Peters, 6 USPQ2d 1390, 1391 (TTAB 1988). In order to hold the design in question de jure functional, it must be shown not just that the item has a function, but also that the performance of that function is enhanced by the particular configuration in which the design is executed. In re R. M. Smith, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). A configuration which

embodies a design which is superior to other available designs for achieving its purpose is de jure functional and it is not registrable on either register. In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). If, however, the design is a feature of the goods which is only one of many equally feasible, efficient and competitive alternatives, then it is considered to be merely de facto functional and may be registered on the Supplemental Register or on the Principal Register if it is inherently distinctive or if it has acquired distinctiveness under Section 2(f) of the Act. In re R. M. Smith, supra; In re Ovation Instruments, Inc., 201 USPQ 116 (TTAB 1968).

The functionality refusal was withdrawn, so the sole issue is whether the de facto functional configuration applicant seeks to register is registrable because it has acquired distinctiveness under the provisions of Section 2(f) of the Act.

To establish secondary meaning, applicant must show that the primary significance of its flange/embossment configuration in the minds of the people who purchase and use drum closures is not the product, but rather is an indication of the producer. Distinctiveness is typically established with evidence of how long the mark has been used, the type and amount of advertising of the mark, and any other evidence that shows that the purchasers of the goods in question associate the proposed mark with a

particular source. In re Pennzoil Products Company, 200 USPQ 753 (TTAB 1991).

Applicant correctly points out that, contrary to the position taken at one point by the Examining Attorney during the prosecution of the application, applicant has the burden of proof with respect to establishing a prima facie case of acquired distinctiveness. In re Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994); Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Applicant does not have to meet the more stringent standard of "clear and convincing evidence" espoused by the Examining Attorney in her second Office Action. Rather, the less strict standard of the preponderance of the evidence is all that is required in order to create the required prima facie case of distinctiveness. The question is whether it is more likely than not that the proposed mark does in fact function as a trademark for the goods identified in the application.

For the reasons set forth below, we find that applicant has established a prima facie case that the configuration does function as applicant's trademark, and that registration on the Principal Register is therefore appropriate under the provisions of Section 2(f).

Our conclusion is based on the evidence submitted by applicant showing that applicant's use of the configuration since 1943 has resulted in its recognition by purchasers and

users of applicant's product as an indication of their source.

Mr. Keating's affidavit establishes that applicant's design is not necessary for competitors to copy in order to compete effectively. That the American Flange product has competed with applicant's goods for fifty years without incorporating the configuration used by applicant may help show that the design is not de jure functional, but it does not establish secondary meaning for applicant's configuration.

In a similar sense, the older operating and service manual shows the configuration, so it establishes that the goods have embodied the configuration sought to be registered for a long time, but the manual does not emphasize the design or otherwise call attention to it as applicant's trademark. The same can be said for applicant's 1950 Annual Report and the recent catalog. The serrations are illustrated and even described, but these exhibits do not demonstrate a basis upon which we could conclude that the configuration is regarded as a source indicator for these goods.

The affidavits and declarations, however, do establish a prima facie case of distinctiveness for applicant's configuration. Mr. Thomas provides information regarding the extent of use and promotion of goods embodying the design. Mr. Rieke gives us details of the huge volume of these products sold and circulating in the various

industries which make use of the drums in which applicant's products are installed.

Even more significant, though, are the three additional declarations submitted with applicant's response to the final refusal to register. All three of the declarants are experienced professionals in the field of drums. One makes drums. One is in the packaging business which uses drums. One makes agricultural chemicals which are shipped in drums. Each of these men states in no uncertain terms that the configuration sought to be registered is unique to applicant's products and signifies the source of those products, distinguishing them from competing goods made by others. This is extremely persuasive evidence that the effect of applicant's long use of the design and whatever promotion it has been given over the fifty-plus years since it was adopted has been to create an association between the configuration and applicant as the single source of the products in which it is embodied.

Although the Examining Attorney contends that this evidence falls short of establishing distinctiveness because applicant did not provide "any information which would assist the examining attorney in determining the value of its customer declarations," we find that the declarations speak for themselves and provide all the information necessary in order to conclude that applicant has at a minimum shown prima facie that the configuration has acquired distinctiveness. The suggestion by the Examining

Attorney that she needed to know what percentage of applicant's customers is represented by the three declarations in order to determine their probative value is without legal or logical support. There is absolutely nothing in this record to contradict the conclusions of these declarants or even to call into question their conclusions. For the Board to reject this evidence and conclude that the configuration has not acquired secondary meaning would be rank speculation on our part.

For the reasons set forth above, we hold that applicant has established a prima facie case of acquired distinctiveness under Section 2(f) of the Act, and that the refusal to register must therefore be reversed.

In order that any registration which may ultimately issue to applicant based on this application will accurately portray applicant's mark, however, it is suggested that applicant submit an amended drawing and an amended description of its mark for the text of the application.

From the affidavits, declarations and arguments put forth by applicant, it is apparent that the present description of the mark is not detailed enough to provide adequate notice to competitors of exactly what applicant's mark is. Although the existing language does refer to the "design configuration of a closure flange which is crimped in place within an embossment of a metal drum," no reference is made to the feature or characteristic which the record shows is the key element in which the secondary meaning has

developed: the serrations created when the embossment is crimped down over the twenty outwardly projecting portions of the flange. In order to correct this deficiency and to describe with greater accuracy the source-indicating aspect of the design, applicant should amend the application to describe the mark as "the configuration of a closure flange with serrated, outwardly projecting portions when it is crimped in place within the embossment of a metal drum, resulting in a multifaceted appearance along the periphery of the flange where the embossment is crimped over it."¹

Correspondingly, although the drawing shows this aspect of the configuration clearly and in solid black lines, the drawing also shows in solid black lines other matter which applicant does not appear to consider to be part of its trademark. In accordance with Trademark Rule 2.51(b)(3), which requires the use of broken lines to indicate matter not claimed as part of the mark, a new drawing should be submitted in which the hole in the flange and the threaded portion thereof are represented in broken lines, just as the surface of the drum is shown in the existing drawing.

¹This language is suggested, but if applicant devises alternative wording that adequately describes its mark, that language would solve the problem with the present description.

In order to facilitate the entry of the amended description of the mark and the amended drawing, the Board will hold the application file for sixty days following the mailing of this ruling before forwarding the application to publication.

R. L. Simms

R. F. Cissel

E. W. Hanak
Administrative Trademark Judges
Trademark Trial & Appeal Board

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